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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,771

11/22/2003

John L. Bala

BALJL/103/US

1452

2543

7590

03/07/2006

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,771

Applicant(s)

BALA, JOHN L.

Examiner

Philip R. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Claim Rejections - 35 USC § 112, Paragraph One**

- [01] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [02] The rejection of claim 20 in the Office action of 7/21/2005 has been rendered moot by its subsequent cancellation.

**Claim Rejections - 35 U.S.C. 112, Paragraph Two**

- [03] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [04] Claim 19 remains rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.
- [05] Applicant has amended the claim, but it still recites the painting of a target area on a video monitor. This requires that the fourth flashtube assembly be pointed at the video monitor, which does not agree with the specification.

**Claim Rejections - 35 USC § 102**

- [06] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [07] The rejection of claims 1-2 & 22 as being anticipated by Imaizumi in the Office action of 7/21/2005 has been overcome by the amendments of 12/14/2005.
- [08] The rejection of claims 1-3 & 22 as being anticipated by Sendai in the Office action

of 7/21/2005 has been overcome by the amendments of 12/14/2005.

**Claim Rejections - 35 USC § 103**

- [09] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [10] Claims 1-16 & 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sendai in view of Moore, Bala & Fort for the reasons set forth in the Office action of 7/21/2005 with respect to claims 1 and 21; 4 and 22; and 9.
- [11] Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sendai in view of Moore, Bala & Fort and in further view of Neuberger, for the reasons set forth in the Office action of 7/21/2005.

**Response to Arguments**

- [12] Applicant's arguments with respect to the Imaizumi reference have been considered but are moot, as the rejection has been withdrawn in view of the amendments of 12/14/2005.
- [13] With regard to the combination of Sendai with Moore and Bala, Applicant firstly recites familiar case law, and secondly recites the Office action of 7/21/2005. This does not constitute an argument.
- [14] Applicant anticipates the combination of Sendai with Moore & Bala, and preemptively argues that the combination of Sendai, Moore & Bala with the teachings of Fort are improper. Specifically, Applicant contends that "the multiple flashtubes recited in claims 1, 21 and 22 [as of the current amendment] do not

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produce light that will generate heat within the probe that is sufficient to harm a patient or to ignite the surgical drapes. Therefore, there is no incentive to add any component to the endoscope to reduce the production of heat within the probe."

As Applicant correctly points out, the specification directly contradicts this assertion on page 9, lines 19-22: "[a]n infrared (IR) filter ...is provided to remove IR [energy] ...during imaging to protect body tissue." Either the heat generated by the multiple flashtubes is sufficient to harm a patient or it is not. In either case, Fort's teaching that of an anti-heat device in the defined light path which "provide[s] necessary thermal protection" (3/51-56) remains relevant for the reasons stated previously. Its positioning within the defined light path (see Figure 1) suggests that it is intended to protect everything beyond the lamp, including the patient's body tissue.

### Conclusion

[15] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vander Salm (5,906,579) discloses a catheter with a light source which includes "an IR filter to avoid applying excessive heat while nonetheless passing sufficient power to be readily visualized through the blood vessel without damaging the tissue therein."

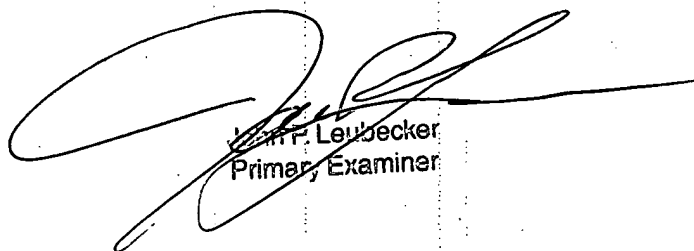
[16] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

- [17] A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
- [18] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [19] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [20] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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[21] prs

  
J. W. F. Leubecker  
Primary Examiner